

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111, and in light of the remarks which follow, are respectfully requested.

Initially, Applicants affirm their election of Group I, claims 1-15, in a telephonic conference on May 10, 2006 between Applicant's Representative George F. Lesmes and Examiner Rodee.

The specification has been amended to delete Comparative Example 7. Claims 2, 3, 12, 13 and 16-19 have been canceled without prejudice or disclaimer. Claim 1 has been amended and is directed to a preferred embodiment where one of the metals is a silicon atom and at least one other metal is from a specified Markush Group; note paragraphs [0013] and [0014] of the specification. New claim 28 is based on canceled claims 2 and 12. Claims 1, 4-11, 14, 15 and 20-28 are now pending in this application.

Claims 1, 2, 5 and 12-15 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Published Patent Application No. 2003/0099890 (Sata et al) for the reasons set forth on pages 3 and 4 of the Official Action. Claims 1, 2, 5, 9 and 11-15 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Published Patent Application No. 2003/0198882 (Gambayashi) for the reasons discussed at page 4 of the Office Action. Claims 1-5 and 8 stand rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent Document No. JP 10-182163 for the reasons presented on pages 4 and 5 of the Office Action. Withdrawal of these rejections is respectfully requested in view of the above amendments and for at least the following reasons.

The present claims are directed to a toner comprising: (1) toner particles composed of a binder resin and a colorant and (2) an external additive composed of composite oxide fine

particles having a specific area of $300 \text{ m}^2/\text{g}$ or less, and containing silicon and at least one of Ti, Zn, Fe, Nb, V, W, Sn and Ge (Claim 1) or where the fine particles are composed of at least two metal atoms selected from Si, Ti, Zn, Fe, Nb, V, W, Sn and Ge. Toners of this composition are not anticipated by the cited references.

Sata et al '809 describes a toner composed of particles containing a resin binder and a colorant. The colorant is composed of composite oxide fine particles of at least two metals. The colorant is not an external additive. The Office Action refers to paragraph [0067] of Sata et al '809. The external additive is silica and not a composite oxide of at least two metals of the Markush group specified in the present claims

Gambayashi '882 discloses a toner where the colorant is composed of fine particles of titanium dioxide coated with a complex oxide of titanium and iron. The colorant is not an external additive.

JP '163 discloses toner particles containing a colorant composed of fine particles of titanium dioxide coated with a complex iron oxide. Again, the colorant of this reference is not an external additive as specified in the present claims.

In view of the above, the §102 rejections over Sata et al '809 or Gambayashi '882 or JP '163 should be withdrawn. Such action is earnestly solicited.

Claim 10 was rejected under 35 U.S.C. §103(a) as obvious over JP '163 for the reasons set forth on page 5 of the Office Action. Reconsideration and withdrawal of this rejection are requested for at least the following reasons.

JP '163 does not disclose or suggest a toner having an external additive as defined by claim 10. Accordingly, the §103 rejection over JP '163 should be withdrawn. Such action is earnestly solicited.

Claims 6 and 7 were rejected under 35 U.S.C. §103(a) as obvious over Gambayashi '882 in view of U.S. Patent No. 6,100,000 (Anno et al) for the reasons set forth on page 6 of the Office Action. Reconsideration and withdrawal of this rejection are requested for at least the following reasons.

Gambayashi '882 does not disclose or suggest a toner having an external additive as set forth in the present claims. Anno et al '000 likewise does not disclose a toner having an external additive as defined herein. Accordingly, the §103(a) rejection based on Gambayashi '882 in view of Anno et al '000 should be reconsidered and withdrawn. Such action is earnestly solicited.

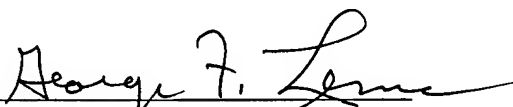
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL PC

Date: June 26, 2006

By:


George F. Lesmes
Registration No. 19995

P.O. Box 1404
Alexandria, VA 22313-1404
703.836.6620